

REMARKS/ARGUMENTS

In the above-mentioned Office Action, claim 162 was rejected under Section 112, first paragraph; claims 139, 141-144, 146, 148-152, 156-160, 162, 164, 177 and 178 were rejected as being unpatentable over U.S. Patent 5,407,718 (Popat et al.) in view of U.S. Patent 5,209,810 (Marschke); claims 140 and 171 were rejected as being unpatentable over Popat in view of Marschke, and further in view of U.S. Patent 3,420,364 (Kennedy, Jr.); claims 145, 161 and 180 were rejected as being unpatentable over Popat in view of Marschke, and further in view of U.S. Patent 5,842,722 (Carlson); claims 147, 153-155, 163, 179 and 181 were rejected as being unpatentable over Popat in view of Marschke, and further in view of U.S. Patent 4,863,772 (Cross); claims 172-174 were rejected as being unpatentable over Popat in view of Marschke, and further in view of U.S. Patent 5,198,275 (Klein); claims 175 and 176 were rejected as being unpatentable over Popat in view of Marschke, and further in view of U.S. Patent 4,704,317 (Hickenbotham et al.); claims 139 and 165 were rejected as being unpatentable over U.S. Patent 5,782,497 (Casagrande) in view of Marschke; claims 169 and 170 were rejected as being unpatentable over Casagrande in view of Marschke, and further in view of Hickenbotham; and claims 166-168 were objected to as being dependent upon a rejected base claim, but would be (potentially) allowable if rewritten in independent form.

In response thereto, claims 139 and 162 have been cancelled without prejudice or disclaimer, claims 140-149, 153-157, 160-165, 171, 172, and 175-178 have been amended and claims 182-226 have been added. Discussions of the patentability of independent claims 140, 182, 223, 224 and 225 follow.

1. Independent Claims 140, 182 and 222

Dependent claim 140 has been rewritten as an independent claim (and old independent claim 139 has been cancelled). And new independent claim 182 is simply old allowable dependent claim 171 rewritten in independent format.

New independent claim 223 is similar to claim 140 and patentable for the same reasons.

Old dependent claims 140 and 171 were rejected as being unpatentable over Popat in view of Marschke and further in view of Kennedy. The Examiner stated that it would have been obvious to add a lacquer layer to the adhesive layer suggested by the combination of Popat and Marschke in order to obtain a tack-free label. In other words, the adhesive label of Popat would no longer have an adhesive back coating.

It is respectfully contended that the Examiner's proposed modification of Popat and Marschke with the teachings of Kennedy is an improper Section 103 rejection.

The Examiner's attention is directed to MPEP 2143.01 where it is stated that "[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)."

(It is further stated in that section of the MPEP that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the prior art are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).")

That is exactly what the Examiner has done in her rejection. She has rendered the prior art adhesive label of Popat or Popat v. Marschke to be unsatisfactory for its intended purpose, which is to adhere to another surface via its adhesive (sticky) back surface. The rejections modifying Popat in view of Marschke and further in view of Kenney are thus improper, and should be withdrawn. The Examiner has accordingly not met her burden of establishing a *prima facie* case of obviousness.

It further is not seen what the purpose of the Popat/Marschke adhesive would be if a lacquer coat were added to it. Even further, to have a waxy lacquer coat on the back of a business card would disadvantageously prevent a user from writing on the back of the card with a pen or pencil.

2. Independent Claims 224 and 225

New independent claim 224 is simply old allowable dependent claim 171 rewritten in independent format.

New independent claim 225 is simply old allowable dependent claim 166 rewritten in independent format.

3. Inventorship Amendment and Petition

Applicants respectfully request that the petition in the Amendment and Petition dated October 22, 2003 to delete the name of Arthur B. Moore as one of the inventors be formally granted with the next action.

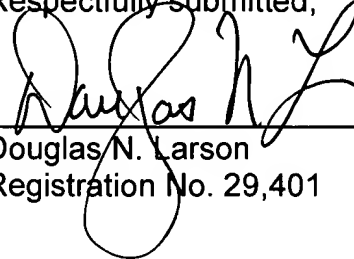
4. Concluding Remarks

Accordingly, it is respectfully contended that all of the claims now pending are patentable over the prior art of record. Issuance of the Notice of Allowance at an early date is thus in order.

If there are any remaining issues, the examiner is encouraged to telephone the below-signed counsel at (213) 689-5142 to seek to resolve them.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 07-1853. Should such additional fees be associated with an extension of time, Applicants respectfully request that this paper be considered a petition therefor.

Respectfully submitted,



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